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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,353	06/01/2001	Brian R. McCarthy	67134-5038	3630
7590	11/01/2007		EXAMINER	
Douglas N. Larson, Esq JEFFER, MANGELS, BUTLER & MARMARO LLP 7th Floor 1900 Avenue of the Stars Los Angeles, CA 90067-4308			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1794	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/872,353	MCCARTHY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Alicia Chevalier	1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 August 2007.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 314-328,330-352,354-374,376-398 and 400-437 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 314-328,330-352,354-374,376-398 and 400-437 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/1/07, 8/21/07

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

Art Unit: 1794

## **RESPONSE TO AMENDMENT**

1. Claims 314-328, 330-352, 354-374, 376-398 and 400-437 are pending in the application, claims 1-313, 329, 353, 375 have been cancelled.
2. Amendments to the claims, filed on August 2, 2007, have been entered in the above-identified application.

## **REJECTIONS**

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Claim Rejections - 35 USC § 112***

4. Claims 319, 343, 367, 390 and 421 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case amended claims 319, 343, 367, 390 and 421 contain(s) the limitation "wherein the printable business card sheet construction has no rupturable color capsules." The specification does not disclose that rupturable color capsules are excluded from the printable business cards, therefore this limitation is considered new matter.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first

paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

The new matter should be deleted.

5. Claims 331, 355, 378, 401 and 431 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case amended claims 331, 355, 378, 401 and 431 contain(s) the limitation "wherein the printable business card sheet construction has no pin-feed strips." The specification does not disclose that pin feed strips are excluded from the printable business cards, therefore this limitation is considered new matter.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

The new matter should be deleted.

#### ***Claim Rejections - 35 USC § 103***

6. Claims 314, 316-320, 325, 330, 331, 332, 336-339, 341-344, 349, 354-356, 361-367, 372, 376-379, 383, 385-390, 395, 400-402, 406, 408-416, 418-425 and 430-437 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip (U.S. Patent No. 5,462,488).

McKillip discloses a sheet of printable business cards, comprising: a cardstock sheet construction having a front side and a back side; a continuous liner sheet releasably secured with ultraremovable adhesive to and covering at least substantially all of the back side of the

Art Unit: 1794

cardstock sheet construction; continuous through-cut lines through the cardstock sheet construction to the back side but not through-cut through the liner sheet; the through-cut lines defining at least in part perimeter edges of printable business cards and a matrix waste portion surrounding the printable business cards; portions of the back side of the cardstock sheet construction forming back side surfaces of the printable business cards; the printable business cards, the matrix waste portion, the liner sheet, the ultraremovable adhesive and the through-cut lines defining at least in substantial part a printable business card sheet construction; the printable business card sheet construction having dimensions such that the printable business card sheet construction can be sheet-fed through a printer or copier for a printing operation on the printable business cards to form printed business cards; areas of the liner sheet covering back sides of all of the through-cut lines, and being structurally capable of holding the printable business cards and the matrix waste portion together when the printable business card sheet construction is sheet-fed through the printer or copier for the printing operation; the ultraremovable adhesive allowing the printed business cards to be removed from the liner sheet and from the matrix waste portion and into individual printed business cards with the ultraremovable adhesive remaining on the liner sheet and not on back side surfaces of the printed business cards and thereby the back side surfaces being non-tacky and the exposed portion of the liner sheet being tacky; and the liner sheet being a solid continuous liner sheet (*figures 5 and 6 and col. 7, lines 16-30 and col. 2, lines 49-56*). The card is deemed capable of being folded.

The preamble/limitation “business card” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed

invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that “business card” as the cut out portion or separable portion of the sheet construction (*specification page 1, lines 3-7 and page 3, line 25 through page 4, line 9*). McKillip’ labels are deemed to meet this limitation because McKillip’ labels are also the cut out portion of the printable material.

It would obvious to modify the laminate sheet construction of McKillip to be sized, constructed and capable of being sheet-fed through a printer or copier for a sheet-fed printing operation on the printable business cards, since one of ordinary skill in the art could have applied the known “improvement” technique, e.g. laser printer/sheet-fed printer, in the same way to the “base” device, e.g. dot-matrix/tractor feeding, and the results would have been predictable to one of ordinary skill in the art. *KSR, 82 USPQ2d at 1396*. Therefore, it would have been obvious to one of ordinary skill in the art to remove the perforated tractor feeding elements and have individual sheets of paper in order to utilize the new and better technology of laser printers, which are sheet fed. Each individual sheet has a solid continuous liner sheet.

The ultraremovable adhesive is deemed to be a suspension polymer ultraremovable adhesive with a primer coat between the ultraremovable adhesive and the liner sheet (*col. 7, lines 35-47*). The printable business card sheet construction is deemed not to have rupturable capsules. The liner sheet comprises base paper (*col. 5, lines 32-34*). The cardstock sheet construction comprises a top-coated cardstock sheet (*col. 9, lines 63-66*).

7. Claims 315, 321-324, 333-335, 340, 345-348, 357-359, 368-371, 380-382, 384, 391-394, 403-405, 407 and 417 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip (U.S. Patent No. 5,462,488) in view of Popat et al. (U.S. Patent No. 5,407,718).

McKillip is relied upon as described above.

McKillip fails to disclose that the printable business cards being arranged in a grid, the grid including a column of printable business cards, and adjacent ones of the printable business cards in the column directly abut one another and share a common edge or entire front faces of all of the printable business cards being free of any visible indicia.

Popat teaches label sheets used for printing with personal computers (*col. 1, lines 12-19*). The label sheets comprise a sheet construction that comprises a label layer, i.e. facestock sheet construction, and an adhesive layer, and backing layer (*col. 2, lines 64-68*), which acts as a release liner (*col. 3, lines 18-19*), i.e. carrier sheet.

Popat's label comprises facestock continuous through-cut lines (*die cut lines, col. 3, line 15*) that pass through the facestock sheet construction to the back side but not through-cut through the carrier sheet (*col. 3, lines 15-21*) and that the through-cut lines are deemed to define at least in part perimeter edges of printable business cards and a matrix waste portion around the printable business cards (*figure 1*). Areas of the carrier sheet are positioned over the back sides of all the through-cut lines and thereby the carrier sheet is constructed and adapted to hold the printable business cards and the matrix waste portion together during the printing operation (*figure 2 and col. 3, lines 15-21*). The carrier sheet and the through-cut lines are deemed to be constructed and adapted to allow the business cards to be removed and separated from the carrier sheet and from the matrix waste portion after the printing operation into individual printed business cards (*figure 1 and col. 3, lines 15-21*). The die cuts also help facilitate ease of feeding into complex printer paths, such as those found on laser printers (*col. 3, lines 1-4*).

McKillip and Popat are analogous because they are both discuss label sheets used for printing with personal computers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the die cut arrangement of the through-cut lines with the cuts only going through the facestock construction and not the carrier sheet of Popat as the die cuttings of McKillip in order to help facilitate ease of feeding into complex printer paths, such as those found on laser printers (*Popat col. 3, lines 1-4*). Furthermore, it would have been an obvious matter of design choice to change the configuration of the through-cut lines, since a modification would have involved a mere change in size of the label. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). Furthermore, it would have been to one of ordinary skill in the art at the time of the invention to have the entire front faces of all of the printable business cards being free of any visible indicia depending on what type if identification card the end user desire, e.g. a free form of there own design or a pre-filled one as a matter of aesthetic design choice. MPEP 2144.04 (I).

McKillip fails to disclose that the dry laminate sheet construction is 8.5 by 11 inches, 8.5 by 14 inches or has A4 width and length dimensions.

Popat discloses that the label sheet may be a standard 8.5 by 11 inch sheet or other dimensions such as sheets with smaller dimensions, legal size or various other sizes which allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (*col. 5, lines 1-11*).

Therefore, it would have been an obvious matter of design choice to change the size of sheet construction, since a modification would have involved a mere change in size. A change in

Art Unit: 1794

size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV).

One of ordinary skill in the art would have been motivated to change the size of the sheet construction in order to allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (*Popat col. 5, lines 1-11*).

8. Claims 328, 398, 428 and 429 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip in view of Hollis et al. (U.S. Patent No. 5,622,758).

McKillip is relied upon as described above.

McKillip fails to disclose that the liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet or that the narrow exposed strip is approximately  $\frac{1}{2}$  inch wide.

Hollis discloses a label sheet comprising a backing sheet and one or more labels affixed to the backing with adhesive (*col. 5, line 62 through col. 6, line 20*). The backing sheet has a leading edge and a trailing edge that extends out to form a narrow exposed strip extending the entire width of the liner sheet (*col. 5, line 67 through col. 6, line 1 and figures 3 and 4*). The label sheet is easily loaded into machinery (*col. 4, lines 49-51*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have McKillip's liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet as taught by Hollis in order to make the sheet material easy to load into machinery.

The exact size of the narrow exposed strip of the liner sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have

Art Unit: 1794

determined the optimum value of a result effective variable, such as size of the narrow exposed strip, through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

9. Claims 326, 327, 350, 351, 373, 374, 396, 397, 426 and 427 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

McKillip is relied upon as described above.

McKillip fails to disclose that an edge of the sheet is thinner than a body of the sheet or that the sheet is calendered.

Examiner's comment: The limitation "the printable business card sheet is calendered" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendered end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the printable business card sheet is calendered," since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (*col. 6, lines 9-16*). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (*col. 1, lines 38-51*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet of McKillip as taught by Hickenbotham, in order to make the edge

thinner than the rest of the sheet and to facilitate dispensing. One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at col. 1, lines 38-51. It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

***ANSWERS TO APPLICANT'S ARGUMENTS***

10. Applicant's arguments in the response filed August 2, 2007 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 09/872,353  
Art Unit: 1794

Page 11

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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10/29/07

*AC*  
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PRIMARY EXAMINER